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Ex parte Lyell (BdPatApp&Int) 17 USPQ2d 1548 (8/16/1990)

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**Ex parte Lyell**

**U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences**

**17 USPQ2d 1548**

Decided August 16, 1990

No. 89-0461

**Headnotes**

**PATENTS**

**1. Patentability/Validity - Specification - Claim adequacy (§ 115.1109)**

Claim which combines description of automatic transmission workstand with description of method for using it violates second paragraph of 35 USC 112, since purpose of that paragraph is to require patentee to provide others with notice of boundaries of protection provided by patent, since manufacturer or seller, at time of making or selling workstand of structure set forth in claim, would have no indication whether it might later be sued for contributory infringement if workstand is used in accordance with claimed method, and since claim is thus not sufficiently precise that possibility of infringement may be determined with reasonable degree of certainty.

**2. Patentability/Validity - Subject matter (§ 115.05)**

**Patentability/Validity - Specification - Claim adequacy (§ 115.1109)**

Claim which is intended to embrace both product or machine and process is precluded by language of 35 USC 101, which sets forth statutory classes of invention in alternative only, and is also invalid under 35 USC 112, second paragraph, since claim which purports to be both machine and process is ambiguous and therefore does not particularly point out and distinctly claim subject matter of invention.

**3. Patentability/Validity - Specification - Claim adequacy (§ 115.1109)**

**Patent construction - Claims - Process (§ 125.1309)**

Single patent may include claims directed to more than one statutory class of invention, but no basis exists for permitting combination of two separate and distinct classes of invention in single claim; this rule is not violated by product-by-process claims, which use process limitations to define product, since such claims are considered to be directed toward product only, and thus encompass only single statutory class of invention, even though they contain process language.

**Case History and Disposition:**

Page 1549

Appeal from final rejection of all claims remaining in application for patent (Robert C. Watson, primary examiner).

Patent application of David L. Lyell, serial no. 845,505, filed March 28, 1986 (automatic transmission tool). From final rejection of all claims remaining in application, applicant appeals. Affirmed.

**Attorneys:**

Jerry C. Lyell, Arlington, Va., for appellant.

**Judge:**

Before Serota J., chairman, Calvert, J. vice chairman, McCandlish, Cohen, and Frankfort, examiners-in-chief.

**Opinion Text**

**Opinion By:**

Frankfort, examiner-in-chief.

This is a decision on appeal from the final rejection of claims 2, 4, 7, 8 and 10 through 12, which are the only claims remaining in this application. 2.

Appellant's disclosure relates to a transmission repair tool in the form of a workstand and to the method of using same in repairing automatic transmissions. The subject matter on appeal is represented by independent claim 2, which reads as follows:

2. An automatic transmission tool in the form of a workstand and method for using same comprising:

a support means,

and [sic] internally splined sleeve affixed upright to said support means,

a threaded adjustment bolt threadably engaged through a hole in the bottom of said support means and projecting upward through said support frame into said sleeve,

and further comprising the steps of

1. positioning the output end of an automatic transmission onto said upright sleeve,

2. removing the internal components of said automatic transmission from the casing of said transmission,

3. repairing and replacing said internal components back into said casing, and

4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt.

The references of record relied upon by the examiner in the final rejection are:

Morawski et al. (Morawski) 3,701,539 Oct. 31, 1972

Hayden, *Hayden-Trans-Tool Catalog*, "Transmission Tools & Equipment," item No. T-1060-A, p. 17 1986-87.

Claims 2, 4, 7, 8 and 10 through 12 stand rejected under 35 USC 112, second paragraph, as being indefinite. According to the examiner, the claims are ambiguously constructed and indeterminate in scope because they purport to claim both an apparatus and method of using the apparatus in a single claim.

Claims 2, 4, 7, 8 and 10 through 12 stand further rejected under 35 USC 102(b) as being anticipated by Morawski. As indicated

Page 1550

on page 2 of the answer, it is the examiner's position that

Insofar as the claim [sic, claim 2] can be understood it is being treated as an apparatus claim. The various method steps are accordingly, non-substantive having no patentable significance. In Morawski et al (14) is a support means, (10, 46) is a sleeve (48) is a threaded adjustment bolt. Sleeve (10) has a seating surface and (46) contains an internal spline. The intended use of the device has not been accorded any patentable weight. Hence, no patentable significance has been accorded to the transmission casing or shaft recitations.

Claims 2, 4, 7, 8 and 10 through 12 were also finally rejected under 35 USC 102(a) as being anticipated by item No. T-1060-A of the Hayden-Trans-Tool Catalog. However, we note that this rejection has now been withdrawn by the examiner (see paper No. 11) in view of the affidavits under 37 CFR 1.131 which accompanied the reply brief of June 10, 1988. Accordingly, only the rejections of the appealed claims under 35 USC 112, second paragraph and 35 USC 102(b) remain for our consideration on appeal.

In traversing the §112 rejection, appellant contends that the apparatus and method involved in the present application are "inextricably related" (brief, page 4) and that the tool is not useful in a practical and patent sense unless the method is disclosed to the user. Appellant urges that we "find that apparatus and method elements of Appellant's claims are sufficiently distinct to enable one skilled in the art of making *or* using such tools to practice the invention" (emphasis in original), and to further find that "the apparatus and method claims are proper within one patent" (brief, page 5).

With respect to the Morawski reference applied by the examiner in rejecting the appealed claims under 35 USC 102(b), it is the appellant's position that "[t]he critical feature of the Lyell device, that of holding the output shaft and coaxial transmission components in a spaced relationship with the outer casing, is absent in the Morawski device" (brief, page 6). We refer to pages 4 through 8 of the brief for the full statement of the appellant's position regarding the issues before us on appeal.

**OPINION**

At the outset, we note that the appellant has chosen not to separately argue with any reasonable specificity the patentability of dependent claims 4, 7, 8 and 10 through 12. Accordingly, these claims will stand or fall with the rejection of independent claim 2. See *In re Nielson*, 816 F.2d 1567, 21 USPQ2d 1525 (Fed. Cir. 1987).

We treat first the rejection of the appealed claims under 35 USC 112, second paragraph. The second paragraph of 35 USC 112 requires a claim to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. In discussing the requirements of the second paragraph of 35 USC 112, the Court of Customs and Patent Appeals in *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970), stated at 166 USPQ 208:

Its purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.

In this same vein, we would note that the statutory class of invention is important in determining patentability and infringement. As indicated by the court in *In re Kuehl*, 475 F.2d 658, 665, 177 USPQ 250, 255 (CCPA 1973), "[E]ach statutory class of claims must be considered independently on its own merits." See also *Rubber Co. v. Goodyear*, 76 U.S. 788, 796, 19 L.Ed 566 (1870) (discussing patentability of different classes of invention), and *Merrill v. Yeomans*, 94 U.S. 568, 24 L.Ed. 235 (1877) (indefinite claim held to be to a process of treating oils rather than the product of the process).

[1] Appellant's independent claim 2, in combining two separate statutory classes of invention in a single claim, in our opinion, would raise serious questions for a manufacturer or seller of a tool like that claimed by appellant regarding infringement. Such a manufacturer or seller would have no indication at the time of making or selling a workstand of the structure set forth in appellant's claim 2 whether they might later be sued for contributory infringement because a buyer/user of the workstand later performs the appellant's claimed method of using the workstand. We therefore find that appellant's claim 2 is not sufficiently precise to provide competitors with an accurate determination of the "metes and bounds" of protection involved so that an evaluation of the possibility of infringement may be ascertained with a reasonable degree of certainty, as discussed by the court in *In re Hammack*, *supra*. Accordingly, for this reason alone we would sustain the examiner's rejection of appellant's independent claim 2 and of dependent

Page 1551

claims 4, 7, 8 and 10 through 12 under 35 USC 112, second paragraph.

[2] As we noted above, the second paragraph of 35 USC 112 requires a claim to particularly point out and distinctly claim the subject matter which the appellant regards as his invention. However, the "invention" referred to in the second paragraph of 35 USC 112 is also subject to the requirements of 35 USC 101. This section of the statute requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). In the situation before us on appeal, it is clear that appellant's independent claim 2 is intended to embrace or overlap two different statutory classes of invention set forth in 35 USC 101. In our view, a claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Further, we must agree with the examiner that a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention. While the examiner has only set forth the rejection of the appealed claims as being under 35 USC 112, second paragraph, we note that he has relied upon 35 USC 101 in supporting his position that appellant's claims on appeal are ambiguously drafted and indeterminate in scope. See page 3 of the examiner's answer. Thus, we consider that whether the appropriate statutory ground of rejection is 35 USC 101 and/or 35 USC 112, second paragraph, the appellant has been clearly apprised of the basis for the rejection and has had a fair opportunity to respond to the basic thrust of the rejection. Compare, *In re Kronig*, 539 F.2d 1300, 197 USPQ 425 (CCPA 1976) and *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

[3] Turning to the appellant's arguments, we first note that the statement on page 5 of the brief concerning "making or using" the appellant's claimed invention would seem to be more appropriately directed at a rejection under 35 USC 112, first paragraph, based upon lack of enablement. However, no such rejection is before us on appeal. Next, we note that while it has long been settled that a single patent may include claims directed to more than one statutory class of invention (e.g., a claim to an apparatus and a separate claim to a method of using or producing the apparatus), we find no basis for permitting a combination of two separate and distinct statutory classes of invention in a single claim. Indeed, the cases cited by the appellant in his brief do not suggest otherwise, as evidenced by the quote (brief, page 5) chosen from *Expanded Metal Co. v. Bradford*, 214 U.S. 366, 385 (1909): "A process and an apparatus by which it is performed are distinct things." Patents are authorized by statute and Congress has indicated that inventions may be patentable only if they fall within one of the statutory classes of subject matter specified in 35 USC 101, e.g., "process, machine, manufacture or composition of matter," see *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 483, 181 USPQ 673, 679 (1974). Historically, these categories of invention have been regarded as "four great and distinct classes of invention." *Ex parte Blythe*, 1885 C.D. 82, 86. The first statutory class, process, is defined in 35 USC 100(b) and refers to "arts", while the last three classes, machine, manufacture and composition of matter, refer to physical things or products. "An applicant who claims a product is not required to state whether it is a machine, manufacture, or composition of matter" and products may fall into alternative classes, e.g., a machine or manufacture. 1 Chisum, *Patents*, §1.02 (1989). However, the classes of machine, manufacture or composition of matter "all differ fundamentally in nature from a process." *Nestle-Le Mur Co. v. Eugene, Ltd.*, 55 F.2d 854, 858, 12 USPQ 335, 339 (6th Cir. 1932). We note that eminent legal writers, such as Robinson, have held similar views. Robinson's "Treatise on the Law of Patents" (1890), at section 511 (page 118), states:

... every claim must define the invention it includes in such a manner as to indicate the class of inventions to which it belongs. While the claim need not state in terms whether the invention claimed is an art [process], a machine, a manufacture, a composition of matter, a design, or an improvement, it must be apparent to which of these great classes the invention does pertain.

See also Deller, *Patent Claims*, Chap. VIII and Chap. IX (2d ed, 1971). As stated in Deller, §133:

A claim is single and is either for a process or product. If the claim were divisible, one part would be for a process and the other for a manufacture and it might be in danger of being held void for ambiguity. An applicant for a patent may separately claim a patentable process and a patentable product, but cannot properly cover them both in one claim. They are proper subjects of separate and distinct claims.

Page 1552

(*Merrill v. I Bann & Ard*, 55 and 94 US 568 and 24 L ed 235; *Goodyear v. Rubber Co.*, 2 Cliff 371 and 76 US 788 and 19 L ed 566; *Durand v. Schulze*, 61 F819).

The dichotomy between process and product classes of invention has also been recognized and noted in the following discussion in *Ex Parte Forsyth*, 151 USPQ 55, 56 (Bd. of Appeals 1965):

A claim such as those before us cannot be both method and apparatus. It must be clear from its wording that it is drawn to one or the other of these mutually exclusive statutory classes of invention. A method or process, as indicated above, is an act or a series of acts and from the standpoint of patentability must distinguish over the prior art in terms of steps, whereas a claim drawn to apparatus must distinguish in terms of structure. This is so elemental as not to require citation of authorities. The Patent Act of 1952 did not abolish the then existing different classes of invention. It reaffirmed the same by Section 101 of USC 35.

We however do recognize that certain types of claims which appear to be "hybrid" are permitted in U.S. patent practice. In particular, we refer to product-by-process claims. While this type of claim format may facially appear to cross the line between statutory classes of invention, we note

that such is not the case. A product-by-process claim merely uses one statutory class of invention (i.e., process limitations) to define or fingerprint another statutory class (i.e., the product) which is not readily susceptible to definition solely by structure or physical characteristics. As the court indicated in *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985) citing *In re Brown*, 459 F.2d 531, 173 USPQ 685, 688 (CCPA 1972) and *In re Pilkington*, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969): Product-by-process claims are not specifically discussed in the patent statute. The practice and governing law have developed in response to the need to enable an applicant to claim an otherwise patentable product that resists definition by other than the process by which it is made. For this reason, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. (citations omitted)

The patentability of a product does not depend on its method of production. (citation omitted) If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. (citations omitted).

Thus, we would distinguish appellant's claim 2 from a product-by-process claim because in a typical product-by-process claim the process referred to is the process of making a product, as opposed to the process of using a product or apparatus, as is set forth in appellant's claim 2 on appeal. We would further note that we consider appellant's claim 2 to be clearly distinguishable from product-by-process claims, since, as noted in the quotation above, such claims have long been considered to be solely "product" claims, and, in contrast to appellant's claim 2, would thus encompass only a single statutory class of invention set out in 35 USC 101.

When it comes to a final consideration of appellant's claim 2, we see no reason or legal basis in the patent law to make an exception to claim practice which has existed for over 100 years. In view of the long-standing practice of requiring a product and a process to be separately claimed, we believe that Congress should speak before the Patent and Trademark Office allows a claim which covers a combination of a product and a process.

In light of the foregoing, it is our conclusion that appellant's claim 2, which purports to be both an apparatus and a process in a single claim, is ambiguous and properly rejected under 35 USC 112, second paragraph. As we indicated earlier, dependent claims 4, 7, 8 and 10 through 12 fall with independent claim 2. See *In re Nielson*, *supra*.

With regard to the examiner's rejection of appealed claims 2, 4, 7, 8 and 10 through 12 under 35 USC 102(b) as anticipated by Morawski, it is our view that since the appealed claims are indefinite and indeterminate in scope for the reasons stated *supra*, it is not possible to apply the prior art to these claims in deciding patentability without disregarding portions of the express wording of the claims and thus resorting to speculation and conjecture as to the particular invention defined therein. We therefore will not sustain the examiner's rejection of the appealed claims under 35 USC 102(b). See *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) and *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962).

In summary, the examiner's decision rejecting the appealed claims under 35 USC 112, second paragraph, is affirmed, while the rejection of these claims under 35 USC 102(b) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the

Page 1553

final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

**AFFIRMED**

#### Footnotes

Footnote 2. While both the examiner's final rejection (paper No. 4) and the appellant's Notice of Appeal (paper No. 5) make reference to claim 1, we note that these references are in error since claim 1 was cancelled by the amendment filed May 8, 1987 (paper No. 3). Thus, only claims 2, 4, 7, 8 and 10 through 12 remain for our consideration on appeal.

Footnote 1. Serota and Calvert were added post hearing in view of the legal issues raised in this appeal. Compare *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) and see *Ex parte Kumagai*, 9 USPQ2d 1642 (BPAI 1988).

Footnote 1. Serota and Calvert were added post hearing in view of the legal issues raised in this appeal. Compare *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) and see *Ex parte Kumagai*, 9 USPQ2d 1642 (BPAI 1988).

- End of Case -

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